

Mail Stop Issue Fee

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Patent Application of Charles A. Eldering et al.

Conf. No.: 6478 : Group Art Unit: 2623
Appln. No.: 09/748,942 : Examiner: Bui, Kieu Oanh T.
Filing Date: 27 December 2000 : Attorney Docket No.: T721-15

Title: Advertisement Distribution system for distributing targeted advertisements in television systems

**APPLICANT'S COMMENTS ON STATEMENT OF REASONS FOR
ALLOWANCE UNDER 37 CFR 1.104(e)**

Responsive to the Examiner's Statement of Reasons for Allowance, included with the Notice of Allowance dated November 14, 2007, and concurrent with payment of the Issue Fee in the above-identified patent application, please consider the following remarks:

REMARKS

The following Remarks are made with respect to the Examiner's Statement of Reasons for Allowance ("Statement"), at pages 2-4 of the Notice of Allowability.

Rule 1.104(e) and MPEP 1302.14 permit the Examiner to set forth a written statement of reasons for allowance under certain circumstances. MPEP 1302.14 expressly provides that "(t)he statement is not intended to necessarily state all the reasons for allowance or all the details why claims are allowed and should not be written to specifically or impliedly state that all the reasons for allowance are set forth." While the Examiner's Statement sets forth at least one reason for allowance, Applicant expressly reserves the right to assert in any future proceedings regarding this application or any patent(s) issuing directly or indirectly therefrom, the allowability and/or allowance of the claim(s) on the basis of any other reason(s) consistent with the prosecution history of the application.

Additionally, certain requirements for the statement of reason(s) are expressly set forth in MPEP 1302.14, including the requirement that, "each statement should include at least (1) the major difference in the claims not found in the prior art of record, and (2) the reasons why that difference is considered to define patentability over the prior art if either of these reasons for allowance is not clear in the record" (emphasis added). The Statement of reason(s) with respect to all of the claims is traversed at least on the ground that it fails to comply with the aforesaid requirement of MPEP 1302.14. Initially, Applicant respectfully submits that it is unclear from the Examiner's Statement which of the claimed features or elements the Examiner considers to be the major difference that are not found in the prior art of record. The Examiner's Statement essentially repeats independent claim 1 in its entirety, highlighting some portions of claim 1 in bold text. Thus, it is not clear, for example, whether the Examiner considers only the highlighted portions of each of these claims to define the differences, whether the non-highlighted portions define the differences, whether the highlighted portions of the claims are examples of significant differences, or whether the highlighted portions are deserving of

particular focus, etc. In view of this lack of clarity, the Statement fails to satisfy express provisions of the MPEP.

In addition, MPEP 1302.14 requires the statement to be “accurate”. The Examiner’s Statement is factually incorrect, in that the Examiner asserts that the claimed subject matter recites, “...wherein the ending program;” (see paragraph bridging pages 2-3 of the Statement). However, none of the allowed claims include such language. Accordingly, since the Examiner’s Statement is factually incorrect in at least the aforesaid instance and since such inaccuracies are contrary to both the spirit of the Rule and the express provisions of the MPEP, it is of no legal effect.

Rule 1.104(e) also limits the Examiners’ ability to provide a statement of reasons for allowance to some degree. The rule states, in pertinent part:

If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the Examiner may set forth such reasoning.

Consequently, where the statement of reason(s) does not clarify the reason(s) for allowance over the prosecution record (or actually further confuses the record), the statement violates Rule 1.104(e). As noted above, the Examiner’s Statement is not clear with respect to which of the claimed features or elements the Examiner considers to be the major difference that are not found in the prior art of record. Thus, the Examiner’s Statement does not further clarify the record. Additionally, as discussed, the Examiner’s Statement is incorrect with respect to which of the features or elements the Examiner considers to be recited in the allowed claims. Thus, the Examiner’s Statement does not further clarify the record in violation of the MPEP and Rule 1.104(e), and is thus of no legal effect.

For the foregoing reasons, Applicant therefore denies acquiescence to such Statement and further denies being bound by any negative inferences that may flow therefrom in any future proceedings regarding this application or any patent(s) issuing directly or indirectly therefrom.

Respectfully submitted,

Date: 12/10/07 By: Andrew W. Spicer

Andrew W. Spicer
Registration No. 57,420
Technology, Patents & Licensing, Inc.
2003 South Easton Road, Suite 208
Doylestown, PA 18901
Telephone: 267-880-1720
Customer No. 27832